

### **REMARKS/ARGUMENTS**

In the Office Action mailed June 16, 2008 (hereinafter, "Office Action"), claims 1-3, 5, 6, 8-12, 14-20, 22, 23, and 25-27 stand rejected under 35 U.S.C. § 102. Claims 4, 13, 21, and 24 stand rejected under 35 U.S.C. § 103. Claims 1, 11, and 17 have been amended.

Applicant respectfully responds to the Office Action.

#### **I. Claims 1-3, 5, 6, 8-12, 14-20, 22, 23, and 25-27 Rejected Under 35 U.S.C. § 102(b)**

Claims 1-3, 5, 6, 8-12, 14-20, 22, 23, and 25-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,466,329 to Mukai (hereinafter, "Mukai"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicant respectfully submits that the claims at issue are patentably distinct from Mukai. Mukai does not disclose all of the limitations in these claims.

Claim 1 of the present application teaches:

obtaining document formatting inputs from a user interface;  
encapsulating the image data in a page description language using the document  
formatting inputs for document formatting, wherein the encapsulating occurs  
at the imaging device;

Further, as explained in the Present Application:

With image data there is no inherent concept of a document. Instead, it is an unframed image of arbitrary size based on an application viewer's interpretation of the images size (e.g., horizontal and vertical sizes) and resolution. Therefore, the

viewer makes arbitrary decisions on how the images are viewed, such as scale and placement.

One improvement, as demonstrated with Sharp ImagePDF which can be generated using a Sharp AR-N275 network scanning feature, encapsulates the image data into portable document format (PDF). By encapsulating the image data into a document format, there is an association with each image to a page. Therefore the document page imposes a structure (i.e., framing) on how the image is viewed.

While this is an improvement, the Sharp ImagePDF format is still limited in that the page properties are arbitrarily set by the MFP device. In other words, at the MFP the user has no control of how the images are framed into the document. Therefore, there is a desire for a method for a user to document frame an image output in a scan operation from an MFP with the same capabilities that the user would have if the output would have been paper (i.e., copy job).

Present Application at ¶¶ 57-59. The Office Action relies on the teaching of lines 31-44 of col. 9 of Mukai for the proposition that this patent teaches “encapsulating the image data in a page description language using the document formatting inputs for document formatting.” Office Action at p. 3. This portion of Mukai, however, has general reference to use of a “control panel 500 . . . to input various settings . . . for copying, printing, facsimile, and document filing operations.” Mukai does not specifically teach that settings for the “number of copies, the size of the copies, the degree of enlargement/reduction, duplex printing” apply to “encapsulating the image data in a page description language using the document formatting inputs for document formatting,” as required by claim 1 of the Present Application. Mukai at col. 9, lines 31-44. In fact, a number of the controls identified in Mukai clearly do not apply to all of the functions, “copying, printing, facsimile, and document filing operations.” For example, “setting the recipient” clearly has no application to the copying or printing operations. Mukai thus does not teach that the “number of copies, the size of the copies, the degree of enlargement/reduction, duplex printing” applies to document formatting inputs received from a user interface for encapsulating image data in a page description language. Thus, Mukai does not teach the “identical invention . . . in as complete detail as is contained in the . . . claim.” MPEP § 2131 (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Mukai. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Mukai does not disclose all of the subject matter of claim 1.

Claims 11 and 17 include subject matter similar to the subject matter of claim 1.<sup>1</sup> Accordingly, Applicant respectfully requests that the rejection of claims 11 and 17 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 2-3, 5, 6, and 8-10 depend directly from claim 1. Claims 12 and 14-16 depend directly from claim 11. Claims 18-20, 22, 23, and 25-27 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 2-3, 5, 6, 8-10, 12, 14-16, 17-20, 22, 23, and 25-27 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

## **II. Claims 4 and 21 Rejected Under 35 U.S.C. § 103(a)**

Claims 4 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukai in view of U.S. Patent Application Publication No. 2002/0114021 to Lavender et al. (hereinafter, "Lavender"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. \_\_\_, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at \*\*37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead,

there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

As explained above, the specified claims depend from allowable subject matter (independent claims 1 and 17) and are thus likewise allowable. Accordingly, Applicant respectfully requests that the rejection of claims 4 and 21 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 17.

### **III. Claims 7, 13 and 24 Rejected Under 35 U.S.C. § 103(a)**

Claims 7, 13 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukai in view of U.S. Patent No. 5,493,634 to Bonk et al. (hereinafter, “Bonk”). This rejection is respectfully traversed.

The standard to establish a *prima facie* case of obviousness is provided above.

As explained above, the specified claims depend from allowable subject matter (independent claims 1, 11 and 17) and are thus likewise allowable. Accordingly, Applicant respectfully requests that the rejection of claims 7, 13 and 24 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 11 and 17.

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<sup>1</sup> Claim 17 claims one type of user interface, a control panel.

Appl. No. 10/787,365  
Amdt. dated September 16, 2008  
Reply to Office Action of June 16, 2008

**IV. Conclusion**

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', written in a cursive style.

/Wesley L. Austin/

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Date: September 16, 2008

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